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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,758	10/17/2003	Michael T.K. Ling	FLM-5686A	1992

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EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,758

Applicant(s)

LING ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

SDD

Specification

1. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 13-14, 18, and 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.
3. Claims 13-14 attempt to broaden or restate the scope of claim 10. Thus, the claims do not further limit the scope of claim 10.
4. Claim 18 limits the second polyolefin to an ethylene/ α -olefin copolymer of claim 17, where claim 17 limits the second polyolefin to an α -olefin copolymerized with an ethylene monomer. The examiner sees no difference in scope between an ethylene/ α -olefin copolymer and an α -olefin copolymerized with ethylene.
5. Claim 27 recites that a first thermoplastic elastomer is a "first styrene-ethylene-butene-styrene block copolymer" and depends from claim 26, where claim 26 recites that the first thermoplastic elastomer is a "styrene-ethylene-butene-styrene block copolymer." The addition of the word "first" does not further limit the scope of the claim.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 15 recites "the second styrene and hydrocarbon copolymer," where there is no antecedent basis for this term.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2, 4-9, 15-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Woo et al. Woo et al. (US 5,356,709) can be found on the applicant's form PTO-1449.

11. Woo discloses a multi-layered non-PVC containing tubing structure comprising an outer layer, a tie layer, and an inner layer (abstract). The outer layer can comprise 40-99% by weight of a polypropylene copolymer having 2-6% polyethylene and 1-60% by weight of a styrene-ethylene-butylene-styrene (SEBS) thermoplastic elastomer copolymer (col. 3 lines 10-17). A second layer, the tie layer, comprises 30-60% by weight of a Hytrel copolyester, 0-20% by weight of a polypropylene copolymer having 2-6% polyethylene, 30-60% by weight of a SEBS thermoplastic elastomer, and 0-30% by

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weight of ethylene-vinyl acetate (col. 3 lines 38-49). Note that the applicant recognizes the exemplified copolyester, Hytrel 4056, as a polyester polyether block copolymer and recognizes the exemplified ethylene-vinyl acetate, UE 697, as a suitable material having the claimed vinyl acetate content. In this sense, the second layer is coaxially mounted within the first layer.

12. Regarding claim 22, it is noted that a core layer comprising a non-PVC containing polymer blend is coaxially mounted within the blended tie layer.

13. Since claims 5-6 only further limit the optional polyamide component of the blend when read into claim 1, which is not present in the outer blend of the reference, claims 5-6 are anticipated. Likewise, since claims 17-19 and 33 only further limit the optional second polyolefin component of claim 1 or 23, which is not present in the outer blend of the reference, claims 17-19 and 33 are anticipated. In other words, when these limitations are read into claim 1, the components are still optional. Therefore, the reference anticipates any further limitations of the optional components.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al. in view of Laurin et al. Laurin et al. (US 5,849,843) can be found on the applicant's Form PTO-1449.

16. Woo applies as above, teaching multi-layered tubing structures having the blend of claimed layer 1 but failing to specify the use of functionalized SEBS polymers. Laurin teaches blends for tubing structures, where the blends comprise the components of claimed layer 1. SEBS copolymers are preferably functionalized with maleic anhydride or other polar monomers to enhance the compatibility with polar polymers (col. 7 lines 37-50). Thus, it would have been prima facie obvious to use maleic anhydride-modified SEBS polymers in the Woo invention to enhance the compatibility of non-polar polymers with polar polymers.

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al. in view of Strassmann. Strassmann (US 6,127,009) can be found on the applicant's Form PTO-1449.

18. Woo applies as above, teaching multi-layered tubing structures for tubing ports but failing to teach a second blend layer coaxially mounted outside the blend layer 1. Strassmann teaches tubing port structures, where the bag is mounted coaxially onto the outside of the tubing (figures). The bags are made of the same blend materials as the outer layers of the tubing to optimize adhesion (examples). It would have been prima facie obvious to use bags of blended materials and mount the bags onto the outer layer

of the tubing to provide conventional bag structures having optimized adhesion to the tubing.

Double Patenting

19. Applicant is advised that should claim 4 be found allowable, claim 23 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

20. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

21. Claims 4 and 23 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,652,942. This is a double patenting rejection.

22. The patented claim differs in language from the present claims by reciting a "first propylene containing polymer" instead of the presently claimed "polypropylene and

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polypropylene copolymers" and by reciting "an amount from about 0%..." for some of the blended components. It is the examiner's position that the scope of the claims is the same, despite the difference in language. The "propylene containing polymer" would only encompass polypropylene homopolymers and polypropylene copolymers. Also, it is the examiner's position that the term "an amount from about 0%" would still encompass 0%, with 0% being the amount. If the applicants intend to exclude 0% and require the presence of any of the optional materials, it is suggested that the claims clarify that the components are "present in an amount up to" the upper limit of the intended range to alleviate any ambiguity.

23. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

24. Claims 1-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,652,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantially overlapping subject matter. The

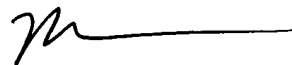
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patented claims suggest all the components of the present claims and therefore are not patentably distinct. The dependent claims of the patent suggest all of the limitations of the present dependent claims. Thus, the claims are obvious variations of the present claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett
Patent Examiner
Art Unit 1711

mdb